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| Pepper Hamilton LLP<br>50th Floor, One Mellon Center<br>500 Grant Street<br>Pittsburgh, PA 15219 |             | EXAMINER<br>HARPER, V PAUL |                     |                  |
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|  |             | 2654                       |                     |                  |

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/681,537

Applicant(s)

GOMAS ET AL.

Examiner

V. Paul Harper

Art Unit

2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 and 33-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28, 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Interview Summary***

1. The examiner acknowledges the teaching in the specification of "information corresponding to the content" and thus the Section 112 rejections are withdrawn. However, the previous Section 103 rejections covered all the limitations and after careful consideration of the Applicants' arguments are maintained.

### ***Claim Rejections - 35 USC § 112***

2. These rejections are withdrawn as being satisfied.

### ***Claim Objections***

3. Claims 39 and 41 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 39 is identical to claim 38, and claim 41 is identical to claim 40.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-9, 12-22, 24-28 and 33-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. (U.S. Patent 5,721,827), hereinafter referred to as Logan, in view of Waldman (U.S. Patent 5,311,175), hereinafter referred to as Waldman.

Regarding **claim 1**, Logan discloses a system for electronically distributing personalized information. Logan's system includes the following:

- a ... user interface ... that, when activated, the interface causes the audio output to announce information corresponding to the content (col. 12, lines 16-22, keyed input [activation] the controls playback of content; col. 34, line 59 through col. 35, line 6; audio announcements and content, navigation using audio prompts and/or button);
- a memory that contains a database of content (Fig. 1, item 107, col. 3, lines 5-10);
- a text-to-speech converter (col. 3, lines 15-18, abstract); and
- an audio output (Fig. 1, items 110 and 113).

Logan teaches the use of an interface with both keyed and voiced command entry (col. 12, lines 17-20), but Logan does not specifically teach "a **tactile** user interface adapted to be operated by a print-disabled individual. However, the examiner contends that this concept was well known in the art, as taught by Waldman.

In the same field of endeavor, Waldman teaches a method for pre-identification of keys on a keypad by passing information regarding the underlying, functionally associated key using tactile information which is of value to a visually impaired

Art Unit: 2654

individual (abstract, col. 2, lines 25-67, dual-press systems where keys are pressed for information (including potential utility) and a second time for function).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Logan by specifically providing the keypad, as taught by Waldman, because it is well known in the art at the time of invention to be advantageous for a visually impaired individual to use such a keypad (Waldman, col. 2, lines 25-30).

Regarding **claim 2**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 1); in addition, Logan teaches "the content comprises compressed audio format content files and compressed text format content files" (col. 3, lines 5-18).

Regarding **claim 3**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 2); in addition, Logan teaches "the device is configured to decompress the text format content files and the text-to-speech converter is configured to deliver the decompressed text format content files in audio format in response to a user input" (col. 3, lines 15-20; col. 4, lines 58-65).

Regarding **claim 5**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 2); in addition, Logan teaches "each audio format content file

Art Unit: 2654

and each text format content file is associated with at least one index file that is stored in the memory" (Fig. 5, col. 17, lines 10-15).

Regarding **claim 6**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 5); in addition, Logan teaches "when a user selects an audio content format file, the text-to-speech converter is programmed to convert selected non-audio format information associated with the audio content format file into an audio format and present the converted selected information to the user as text-to-speech (col. 3, lines 14-20).

Regarding **claim 7**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 2); in addition, Logan teaches "a decompression module that decompresses a user-selected compressed audio format content file or text format content file in real time during presentation of the file in audio format to a user" (col. 3, lines 1-18, playing audio files that are compressed necessarily involves a decompression step).

Regarding **claim 8**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 1); in addition, Logan teaches the use of "a communication means that receives content updates from a remote computing device" (Fig. 1, items 123, 121, and 117; col. 6, line 45 through col. 7, line 21).

Regarding **claim 9**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 1); in addition, Logan teaches “a processor programmed with time scale modification functions that adjust a delivery speed of the content for a plurality of file types when the content is presented to a user through the audio output” (col. 7, lines 44-45; col. 8, lines 60-61; col. 3, lines 13-19; compressed audio and/or text files converted into audio).

Regarding **claim 12**, Logan in view of Waldman discloses a system for electronically distributing personalized information. Logan’s system includes the following:

- a server that includes a server content database and a server subscriber database (Fig. 1, “Program Data Library”, item 143; Fig. 2)
- one or more portable electronic devices, each portable electronic device in communication with the server (Fig. 1, item 103; col. 3, lines 1-2, a laptop is a portable electronic device).

The remaining limitations are similar to those found in claim 1 and are rejected for the same reasons.

Regarding **claim 13**, Logan in view of Waldman teaches that “each portable electronic device is programmed to periodically communicate with the server, receive an update from the server content database, and update the device content database with

Art Unit: 2654

the update from the server content database” (Fig. 2, col. 1, lines 38-47; col. 2, line 3, col. 5, lines 20-37).

Regarding **claim 14**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 12; in addition, Logan teaches that “the content database of the portable device comprises compressed audio format content files and text format content files” (col. 3, lines 5-18).

Regarding **claim 15**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 14); in addition, Logan teaches the use of an “audio file generator in communication with the server, wherein the audio file generator pre-processes the compressed audio format content files” (Fig. 6, step before step 440).

Regarding **claim 16**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 12); in addition, Logan teaches the use of “at least one communications link between the server and a plurality of remote content providers, wherein at least a portion of the content in the server content database has been received from the plurality of remote content providers via the at least one communications link” (Fig. 4, item 315, col. 4, lines 58-61; col. 12, lines 35-45).

Regarding **claim 17**, this claim has limitations similar to claim 9 and is rejected for the same reasons.

Art Unit: 2654

Regarding **claim 18**, this claim has limitations similar to those in claims 1, 9, 12 and 13 and is rejected for the same reasons.

Regarding **claim 19**, this claim has limitations similar to those in claim 15 and is rejected for the same reasons.

Regarding **claim 20**, this claim has limitations similar to those in claim 16 and is rejected for the same reasons.

Regarding **claim 21**, this claim has limitations similar to those in claim 5 and is rejected for the same reasons.

Regarding **claim 22**, this claim has limitations similar to those in claim 13 and is rejected for the same reasons.

Regarding **claim 24**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 18); in addition, Logan teaches that "in response to a request from a user to receive a content file, verifying that the user is authorized to receive the requested content file" (col. 10, lines 9-20).

Regarding **claim 25**, Logan in view of Waldman discloses a system for electronically distributing personalized information. Logan's system includes the following:

- at least one volume control (col. 3, lines 29-31);
- a document library control (Fig. 5, col. 7, lines 13-45; col. 13, line 55 through col. 14, line 41);
- a table of contents control for selecting a table of contents in the document library (Fig. 5, col. 7, lines 21-45, for creating a selections file, col. 32, lines 51-67).
- a document selection control (Fig. 5, col. 7, lines 13-45); and
- a plurality of navigation controls for navigating through the document library and through individual documents selected from the library (col. 13, line 55 through col. 14, line 41);
- wherein at least one of the navigation controls ... elicits auditory information relating to at least one of the individual documents when selected (col. 12, lines 16-22, keyed input the controls playback of content; col. 13, line 55 through col. 14, line 41; col. 34, line 59 through col. 35, line 6, navigate using audio information and/or buttons, useful for drivers...);

Logan teaches the use of an interface with both keyed and voiced command entry (col. 12, lines 17-20; col. 34, line 59 through col. 35, line 6, buttons) and as stated above this interface has a variety of functions, but Logan does not specifically teach "wherein at least one of the navigation controls are **adapted to be tactilely operated**

Art Unit: 2654

**by a print-disable individual...."** However, the examiner contends that this concept was well known in the art, as taught by Waldman.

In the same field of endeavor, Waldman teaches a method for pre-identification of keys on a keypad using tactile information which is of value to a visually impaired individual (abstract, col. 2, lines 25-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Logan by specifically providing the keypad, as taught by Waldman, because it is well known in the art at the time of invention to be of immense values for a visually impaired individual to use such a keypad (Waldman, col. 2, lines 25-30).

Regarding **claim 26**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 25); in addition, Logan teaches the use of "at least one bookmark control" (col. 14, line 41-45).

Regarding **claim 27**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 25); in addition, Logan teaches that "the plurality of navigation controls include a forward control and a back control (col. 13 line 55 through col. 14, line 41, SKIP--forward, BACK commands; col. 34, lines 59-68, users has the ability to browse, skip ...).

Regarding **claim 28**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 25); in addition, Logan teaches that “the plurality of navigation controls include a document start control and a document end control” (starting col. 12, “User Playback Controls, “GO”, Skip, col. 12, lines 21, interrupt playback).

Regarding **claim 33**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 1). In addition, Logan teaches “the information corresponding to the content comprises at least one of the following: text of a document, a title, a table of contents, a hyperlink, a page number, a content type, a library identifier, a paragraph from the content, a sentence from the content, a word from the content, a bookmark, ordering information, an album, a performer, song lyrics or a song genre” (col. 34, lines 59 through 67, audio announcements, content, cross-referencing and indexing information .. can browse and skip without looking at the display .. navigate using audio prompts and/or buttons; Fig. 3, playback session; col. 12, lines 16-22; player mechanism includes keyboard ... for keyed commands; col. 3, lines 14-18, associated text which may be converted to speech; col. 17, lines 57-67, segment record, audio announcements ... of subjects and topics; col. 28, line 16 through col. 29, line 19; announcements: topic , narrative text, paragraphs, sentences, country music, ...etc. ).

Regarding **claim 34**, this claim has limitations similar to claim 33 and is rejected for the same reasons.

Art Unit: 2654

Regarding **claim 35**, this claim has limitations similar to claim 33 and is rejected for the same reasons.

Regarding **claim 36**, this claim has limitations similar to claim 33 and is rejected for the same reasons.

Regarding **claim 37**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 1). In addition, Waldman teaches:

- the content comprises an audio format file (abstract, programming includes .. audio file); and
- the information corresponding to the content comprises converted non audio format information associated with the audio format file (abstract, programming includes parallel audio and text transcript files).

Regarding **claim 38**, this claim has limitations similar to claim 37 and is rejected for the same reasons.

Regarding **claim 39**, this claim has limitations similar to claim 37 and is rejected for the same reasons.

Regarding **claim 40**, this claim has limitations similar to claim 37 and is rejected for the same reasons.

Art Unit: 2654

Regarding **claim 41**, this claim has limitations similar to claim 37 and is rejected for the same reasons.

5. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan in view of Waldman and further in view of Kiraly et al. (U.S. Patent 6,324,511), hereinafter referred to as Kiraly.

Regarding **claim 4**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 2), but Logan does not specifically teach "the text format content files have been pre-processed to filter material that is not necessary for text-to-speech conversion." However, the examiner contends that this concept was well known in the art, as taught by Kiraly.

In the same field of endeavor, Kiraly discloses a method for multimodal information presentation to computer users with a visual impairment. In addition, Kiraly teaches the use of filters to filter out text that will be processed by text reader software (col. 14, lines 41-51).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Logan in view of Waldman by specifically providing the filtering, as taught by Kiraly, because it is well known in the art at the time of invention for the purpose of eliminating extraneous content (Kiraly, col. 14, line 46).

Art Unit: 2654

Regarding **claim 11**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 1), but Logan does not specifically teach "the print-disabled individual is at least one of blind, visually impaired, dyslexic, or of less than complete literacy." However, the examiner contends that this concept was well known in the art, as taught by Kiraly.

In the same field of endeavor, Kiraly discloses a method for presentation of information to computer users with dyslexia, reading disabilities or visual impairments (title). Kiraly further teaches that one approach is to read text-based data with a synthesizer (col. 14, lines 41-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Logan in view of Waldman by specifically providing support for print-disabled individuals, as taught by Kiraly, because it is well known in the art at the time of invention that such individuals need access to computers (Kiraly, col. 1, line 65 through col. 2, line 20).

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Logan in view of Waldman and further in view of Tjaden (U.S. Patent 6,122,617), hereinafter referred to as Tjaden.

Regarding **claim 10**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 1), but Logan does not specifically teach the use of a "decryption module that, when a user selects a content file that is encrypted, decrypts

Art Unit: 2654

the selected content, the examiner contends that this concept was well known in the art, as taught by Tjaden.

In the same field of endeavor, Tjaden discloses a personalized audio information delivery system that uses text-to-speech synthesis and encryption (Tjaden, col. 3, lines 5-10; col. 5, lines 5-10 and 60-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Logan in view of Waldman by specifically providing the encryption capability, as taught by Tjaden, because it is well known in the art at the time of invention for the purpose of providing privacy over data transport networks (Tjaden, col. 5, lines 8-10).

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Logan in view of Waldman and further in view of Kikinis (U.S. Patent 6,055,566), hereinafter referred to as Kikinis.

Regarding **claim 23**, Logan in view of Waldman teaches everything claimed, as applied above (see claim 18), but Logan does not specifically teach "the step of periodically updating is performed by providing the user with a replacement memory that contains the updated text format content files and audio format content files.

However, the examiner contends that this concept was well known in the art, as taught by Kikinis.

In the same field of endeavor, Kikinis discloses a customizable media player with online/offline capabilities. Kikinis's system includes removable memory that can store documents used for text-to-speech (col. 2, lines 41-50, col. 6, lines 10-16).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Logan in view of Waldman by specifically providing replacement memory, as taught by Kikinis, because it is well known in the art at the time of invention for the purpose of allowing updates while the device is offline.

### ***Response to Arguments***

8. Applicant's arguments filed 10/11/05 have been fully considered but they are not persuasive.
9. Applicants assert beginning on page 13:

***First***, independent claims 1, 12, 18 and 25 each incorporate features not disclosed in the prior art cited by the Examiner. To establish obviousness, all of the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. Neither Logan nor Waldman teaches or suggests a tactile user interface or navigation control that, when activated, announces information or elicits an auditory response that relates to content in a database.

Although Logan describes a database of audio content, it does not disclose or suggest a user interface with navigational tools that help a print-disabled individual identify or locate the content. Rather, Logan merely describes a standard computer (103 in FIG. 1) and keyboard (119 in FIG. 1) that allow a user to search a database. (See also col. 3, lines 61-64.) In fact, Logan does not describe a user interface that announces information or elicits an audio response at all.

Waldman merely teaches a telephone keypad that speaks the name of the key or other pre-recorded information that is specific to the key. Waldman does not describe a user interface that announces information corresponding to database content. In fact, Waldman does not describe a database of audio content at all.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Logan discloses a database of audio content (col. 3, lines 5-10; Fig. 1, item 107) and a mechanism to playback the audio content (or "information corresponding to the content" which as defined by the Applicants includes speaking the entire content file; see Applicants' comments 10/11/05, p. 12, lines 4-7) after a keyed input (col. 12, lines 16-22). Furthermore, Logan teaches the ability to navigate program content using audio prompts and/or a small number of buttons (col. 34, line 58 through col. 35, lines 7, suggesting that such a feature is less distracting for drivers).

Waldman teaches the pre-identification of keys and switches that could "be linked to a voice-synthesizer or other information-giving means capable of decoding the Touch and passing appropriate information to the user regarding the underlying, functionally associated key" (col. 2, lines 47-52). Waldman gives examples of the use of such keys that go well beyond merely speaking the name of the key (cols. 9 and 10, col. 16, starting with practical examples) including an elevator that gives "why-to" information regarding the objective of a corresponding press (e.g, touch the "Floor 1" key and be given information about what is on Floor 1; col. 9, lines 52-67; col. 15, lines 22-30). Furthermore, Waldman teaches that this underlying functionality can be programmed (col. 15, lines 15-22).

Art Unit: 2654

Thus the examiner maintains that Logan in view of Waldman (see §11 for motivation to combine) teaches "tactile user interface or navigation control that, when activated, announces information or elicits an auditory response that relates to content in a database."

10. Applicants assert on page 14:

**Second**, Logan and Waldman are in dissimilar arts To rely on two references under 35 U.S.C. § 103, the references must be in analogous arts. MFEP § 2141.01(a).

Logan relates to message distribution systems that are implemented on a personal computer. (See FIG. 1 and col. 3, lines 61-64) Waldman relates to keypads for devices such as telephones and methods of conveying information "about such keys" to a user. (See col. 1, lines 17-23.) One of ordinary skill in the art of computing devices is not likely to search for teachings from the art of telephones, nor is one of skill in the art of telephones likely to search for teachings from the art of computers. This is illustrated by the fact that none of the "Fields of Search" listed on the face of the Logan patent appear in the "Fields of Search" for the Waldman patent, and none of the "Fields of Search" listed on the face of the Waldman patent appear in the "Fields of Search" for the Logan patent.

In response to applicant's argument that Logan and Waldman are nonanalogous arts, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Logan discloses method of information access using keyboards and buttons (Fig. 1, item 119, col. 34, line 59 through col. 35, line 6, also suggesting that for a diver button, selection can be distracting). Waldman discloses a method for pre-identification of keys which would be useful for the visually impaired or drivers (col. 2,

Art Unit: 2654

lines 23-33). Thus both Logan and Waldman teach the relevance of keys with "tactile" feedback.

11. Applicants assert on page 14:

**Third**, the Examiner has not set forth a motivation to combine the teachings of Logan nor Waldman. Obviousness can only be established if the references themselves either explicitly or implicitly state a motivation to combine. MPEP § 2143.01,

In the Office Action (on page 4), the Examiner states that "it is well known at the time of the invention to be advantageous for a visually impaired individual to use such a keypad." On pages 15 and 16, the Examiner describes possible results of combining Logan with Waldman. However, the mere fact that references can be combined does not in itself render the combination obvious. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Even if a combination of Logan with Waldman were to result in the claimed invention (which Applicants traverse, as described above), the Examiner does not explain why the combination is expressly or implicitly suggested in the references themselves. Since Logan does not describe the use of a keypad, and neither Logan nor Waldman describe or suggest a tactile interface that speaks information corresponding to content in a database, neither Logan nor Waldman suggests the desirability of the claimed invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as stated in the

Art Unit: 2654

rejection, Waldman teaches that tactile keys would be of immense value for a visually impaired individual (col. 2, lines 25-33).

12. Applicant asserts on page 15:

***Fourth***, a modification of Waldman to combine it with Logan would change the principle of operation of Waldman. A proposed modification cannot change the principle of operation of a reference. MPEP §2143.01. The stated purpose of Waldman is to provide a "key and pushbutton apparatus and a method of conveying identification, instruction or description information about such keys or buttons." Col. 1, lines 17-20 (emphasis added). "The method and apparatus of the instant invention [of Waldman] depend upon ... passing appropriate information to the user regarding the underlying, functionally associated key." Col. 2, lines 37-52 (emphasis added). The purpose or principle of operation of Waldman is not to announce any information relating to content stored in a database. Rather, "the functional objectives of the invention [of Waldman] is simply to provide information about a key or group of keys to a user." Col. 3, lines 17-19 (emphasis added).

Waldman discloses "a method and apparatus for keypads, for conveying audible, visual or tactile information to a user regarding the identity, function, proper usage or potential utility of a given key or group of keys" (emphasis added, abstract). Descriptors such as "information", "function" and "potential utility" clearly indicate that Waldman envisions a very broad range of applications for his invention which do not preclude announcing information relating to content stored in a database as taught by Logan in view of Waldman in the above rejections.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 2654

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to V. Paul Harper whose telephone number is (571) 272-7605. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (571) 272-7602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2654

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

03/03/2005

V. Paul Harper  
Patent Examiner  
Art Unit 2654



RICHMOND DORVIL  
SUPERVISORY PATENT EXAMINER